

REMARKS

Claims 1-5, 7-14 and 16-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fairweather in view of Saeki in view of Dekura in view of Parker *et al.* Claim 19 has been canceled. Claims 6 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fairweather in view of Saeki in view of Dekura in view of Parker *et al.*, further in view of Watanabe *et al.*

In order to substantiate an obviousness rejection, certain requirements must be met as set forth in Section 2143 of the MPEP.

Section 2143 of the MPEP states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach, or suggest all the claim limitations.

As set forth below, the Applicants believe that a *prima facie* case of obviousness has not been established by the prior art.

Fairweather, which is directed at “the manufacturer of mobile telephones to protect the magnesium alloy die casting at the heart of the equipment, teaches a “basic process sequence” of: 1) alkaline soak clean; 2) chromic acid based pickle; 3) fluoride acid dip; 4) electroless nickel plate in fluoride containing solution. Fairweather fails to teach, suggest or motivate one to apply chromium layer over a nickel coated body. This

is admitted by the Examiner on page 3 of the Office Action: "It does not teach applying a chrome layer over the Nickel layers, or that the piece of magnesium alloy would be useful in a golf club head, or to heat treat the coated material." If Fairweather teaches anything concerning the use of chromium, it would be against using more chromium: "It would appear that adhesion improves as the amount of chromium on the surface decreases." See page 117, column 2.

Saeki teaches coating a thin chromate film a club head composed of steel with three layers of different nickel plating. The chromate film is applied by immersing the nickel plated club head in a bath of a specific chromate solution and subjecting it to a voltage of five volts for 30 seconds.

Dekura discloses a club head composed of magnesium alloy or aluminum alloy. Dekura claims to disclose a high moment of inertia club head. Without discussing the moment of inertia claim, Dekura teaches to reduce the thickness of the head, which teaches away from nickel plating.

Parker *et al.*, discloses heat treating a nickel-phosphorus alloy coating beryllium, aluminum titanium, iron, nickel, copper and their alloys. Parket *et al.*, fails to disclose heat treating a golf club head component composed of a two layers nickel plating on a magnesium alloy with a chromium layer.

Watanabe *et al.*, teaches electroless plating a synthetic fiber.

The prior art fails to provide all of the limitations of the claims, and provides no suggestion, motivation or teaching to combine the references. Thus, the Applicants believe that the prior art fails to render the invention of the original claims as obvious.

10/708,896

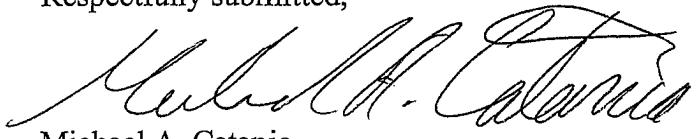
Amdt. Dated Apr. 21, 2006

Resp. to Off. Action dated Dec. 29, 2005

Therefore, the Applicants respectfully request that the Examiner reconsider the rejections of the claims, and issue a Notice of Allowance for the Present Application.

Respectfully submitted,

April 21, 2006



Michael A. Catania
Registration Number 36,474
Attorney for Applicants
Callaway Golf Company
2180 Rutherford Road
Carlsbad, California 92008-8815
Telephone: 760-930-8493
Facsimile: 760-930-5019
E-mail: MikeCa@callawaygolf.com